

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ESPE

Examiner: Davis, J.

Serial No.: 10/617,977

Art Unit: 1771

Filing Date: July 11, 2003

Confirmation No.: 4056

Title: Press Pad For Multi-Daylight Presses

Attorney Docket No. 912.001

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Davis:

In response to the Advisory Action mailed May 25, 2007, Applicant hereby requests that a Pre-Appeal Brief Conference be held in the above-captioned matter. A Notice of Appeal is enclosed herewith. The Office is hereby authorized to charge Deposit Account No. 50-1170 the amount of \$310.00 which includes the \$250.00 associated with entry of the Notice of Appeal and the fee for a one-month extension of time. For the reasons set forth below, Applicant believes that the present case is in condition for allowance. Accordingly, favorable consideration of the following is respectfully requested.

REMARKS

In the Advisory Action dated May 25, 2007, the Examiner refused to enter the Amendments filed May 10, 2007 asserting that the amendments raise new issues that would require further search and/or consideration and alleging that the particular combination of elements set forth in the proposed claim 1 was not previously considered. The undersigned discussed this matter with the Examiner prior to Applicant's filing of the response. Applicant thought it was agreed upon that the amendments and replacement drawing sheet were clarifying amendments and as such, that the subject matter of these amendments had been previously considered. Even so, as the Examiner has refused to enter the amendment, the subject matter of this conference request is the propriety of the outstanding rejections as set forth in the Final Office Action of March 8, 2007 in view of the claims as presented in the Response filed December 12, 2006.

The Examiner rejected claims 1, 2, 4, 6-8, and 11-24 under 35 U.S.C. §112, first paragraph alleging that "It does not appear that applicant contemplated the alternating types of threads to have equivalent diameters." The Examiner's rejection further noted a discrepancy between that which is called for in the claims and that which is shown in Fig. 1. Applicant presented a replacement drawing sheet with the Response filed May 10, 2007. Although the Examiner indicates that the arguments regarding the diameter of the thread accompanied by the proposed drawing would be sufficient to overcome the rejection under 35 U.S.C. §112, first paragraph, the Examiner has mischaracterized the rejection. That is, the subject matter of which the Examiner complains is disclosed in at least paragraph [0024] of the application. As stated therein, the press pad fabric is formed from a first thread 2 and a second thread 3. The first thread 2 includes a core 4 and a sheath 5 having a diameter of 1.5 mm. The second thread includes a core 6 and a sheath 7 that also has a diameter of 1.5 mm. Accordingly, as the sheath is the outer part of either thread 2 or 3, the diameters of both threads are disclosed as being the same. The replacement drawing sheet was presented such that the drawing would more closely comport to this disclosure. Regardless, that which is

called for in the claims is disclosed in the specification as filed, and therefore the §112, first paragraph rejection is simply improper.

The Examiner rejected claims 1, 2, 4, 6, 8, 11-13, 15-18, and 20-24 under 35 U.S.C. §103(a) as being unpatentable of Espe (US 2001/0029139) in view of Kositzke (USP 4909284). The Examiner also rejected claims 7, 14, and 19 under 35 U.S.C. §103(a) as being unpatentable over Espe in view of Kositzke and further in view of Douglas (USP 5855733). In setting forth the rejections, the Examiner simply states that the rejections are substantially as set forth in the last Office action. The rejections set forth in the Final Office Action of March 8, 2007 and those presented in the Office Action September 13, 2006 fail to establish where each every limitation of the claims is disclosed, taught, or suggested in the art of record. Specifically, the outstanding rejection ignores the subject matter associated with the amendments presented in the Response filed December 12, 2006. Even so, as that which is called for in the claims is not taught, suggested, or disclosed in the art of record, Applicant believes the present claims are patentably distinct thereover.

Claim 1 calls for, in part, a press pad wherein a diameter of the sheath of the first type of thread is generally equal to a diameter of the sheath of the second type of thread such that a diameter of one of the two types of thread is generally equal to a diameter of the other of the types of thread. Claims 11 and 18 define a press pad having a first and a second type of thread wherein a diameter of the first type of thread is generally equal to a diameter of the second type of thread. The art of record simply does not teach, suggest, or disclose a press pad having such a construction. Such an understanding is apparent from the Examiner's failure to address these limitations in the rejections set forth in the Office Action mailed March 8, 2006.

The Examiner asserts in the Final Office Action of May 8, 2007 that the prior art rejections set forth in the Final Office Action of May 8, 2007 are "substantially as set forth in the last Office action". Such a rejection fails to consider or address each and every

limitation of the claims. Simply, there is no way that the previous rejection addressed the subject matter of the subsequent amendments to the claims. Accordingly, the Examiner has simply failed to establish a *prima facie* obviousness rejection of the pending claims.

As set forth in the Final Office Action of March 8, 2006, the Examiner rejected the claims for the same reasoning set forth in the previous Office Action even though Applicant amended the claims to include the limitations discussed above. With respect to the additional limitations, e.g., that the claimed pad has first and second threads with different elasticities and similar diameters, the Examiner clearly did not consider these additional limitations in considering the patentability of the claims. The Examiner simply states that “Applicant argues that the claims now require the threads to have generally equal sheath and thread diameters” and that “this does not appear to be commensurate in scope with claims.” The Examiner then referred Applicant’s attention to the 35 U.S.C. §112, first paragraph rejection without any explanation as to where or how the art of record teaches, suggests, or discloses the claimed subject matter. As each of the references teaches individual thread constructions -- such as Espe, threads having dissimilar diameters -- such as Kositzke, or is silent as to any relation between the elasticity and diameter of threads such as Douglas et al., the art or record is devoid of any teaching, suggestion, or disclosure of that which is called for in the present claims. Applicant thought this understanding had been agreed to with the Examiner prior to the May 10, 2007 filing.

The Examiner’s assertion that the “particular combination of elements set forth in the proposed claim 1 has not been previously considered” mischaracterizes the nature of the amendment presented in the Response filed May 10, 2007. That is, the amendments presented therein clarified that which is called for in claim 1. That is, Applicant did not add or otherwise change the association of the assembly defined by claim 1 but rearranged the terms to improve the readability and ease of understanding that which is defined by the claim. That is, Applicant did not amend claim 1 to further define over the art of record but amended claim 1 to improve the readability of the claim. Accordingly, if the Panel prefers

Applicant: ESPE
Serial No. 10/617,977
Page 5 of 5

the language of claim 1 as presented in the Response of May 10, 2007 as compared to the language of pending claim 1, the Examiner is hereby authorized to amend claim 1 to comport with the language presented in the Response of May 10, 2007 if it would expedite resolution of this matter.

For the reasons set forth above, Applicant believes that which is called for in the claims is patentably distinct over the other of record, and any combination thereof. Therefore, Applicant respectfully requests a notice of allowance of claims 1, 2, 4, 6-8 and 11-24. Furthermore, in addition to the authorizations above, the Office is hereby authorized to charge any other applicable fees, or credit any overpayments, to deposit account number 50-1170. The Examiner and other members of the Panel are cordially invited to contact the undersigned should any informal matters remain which would hinder the passage of the above-captioned matter to issuance.

Respectfully submitted,



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